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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,179	02/01/2002	Johannes C.L. Auwens	PHN 17,172A	2006

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EXAMINER

DINH, TAN X

ART UNIT PAPER NUMBER

2627

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/061,179

Applicant(s)

AUWENS ET AL.

Examiner

TAN X. DINH

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/439,198.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1) This application is a Continuation Application of S/N 09/439,198, filed on 11/12/1999 and now is US 6,377,518; which has foreign priority claimed to foreign application filed in European Patent Office (EPO) as:

- European Patent Office (EPO) 98203858.0, filed on 11/16/1998.

2) The preliminary amendment filed 2/01/2002 is acknowledged. Claim 10 has been canceled. New claims 11-25 currently been added.

3) The I.D.S filed 2/01/2002 has been considered by the Examiner. However, the Japan and/or foreign document(s), if they have not been written in English, are considered to the extent that could be understood from the English Abstract and the drawings.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

4) Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase " elements of the control information " (claim 13) is unclear and cannot be understood. The claim did not specific

recite the control includes a plurality of elements, therefore, it is not clear where are these elements come from.

5) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed Terminal Disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of

record may sign a terminal disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6) Claims 1-9 *and* 11-25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,377,518. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims 1-14 of U.S. Patent No. 6,377,518 disclose all the features as claimed in claims 1-9 *and* 11-23, such as, providing real-time video information and control information related thereto, the real-time video information being subdivided into cells, the cells being independently playable portions of the video information, and the control information including playback parameters for reproducing sequences of the cells, selecting a starting point within a recording area of an optical record carrier, the starting point being after and separated from the beginning of the recording area for creating a free area between the beginning of the recording area and the starting point, recording the real-time information at positioned after the starting point according to a recording format, and recording the control information in the free area according to the recording format, except to specifically show

that the information signal is video. However, this different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

Claims 1-14 of U.S. Patent No. 6,377,518 disclose all the features as claimed in claims 24 and 25, such as, providing real-time video information and control information related thereto, the real-time video information being subdivided into cells, the cells being independently playable portions of the video information, and the control information including playback parameters for reproducing sequences of the cells, selecting a starting point within a recording area of an optical record carrier, the starting point being after and separated from the beginning of the recording area for creating a free area between the beginning of the recording area and the starting point, recording the real-time information at positioned after the starting point according to a recording format, and recording the control information in the free area according to the recording format, except to specifically show an optical write/read heads, a head position and a driver for rotating the optical disk. However, this different is not a patentable weight since the optical write/read heads for reading and writing information data, a head position for positioning the

head and a driver for rotating the optical disk are essential elements and inherent in every data recording device (without these elements, the recording/reproducing device cannot be functioned as normal). Whether the optical write/read heads, head position and driver are positive recited in the body of the claim, found in the preamble of the claim or omitted is merely a selection between combination and sub-combination of elements used in overall system and that would not making them patentable distinction.

7) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is reminded that in amending in response to a rejection of claims (if the rejection involves with any applicable arts), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).

Form PTO-892 is attached herein.

8) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN Xuan DINH whose telephone number is (571)-272-7586. The examiner can normally be reached on MONDAY-FRIDAY from 8:00AM to 5:30PM.

Art Unit: 2627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TAN DINH
PRIMARY EXAMINER

June 19, 2006